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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/790,332	03/01/2004	Jing Zhu	08226/1200369-US1	9009
38880	7590	03/06/2006	EXAMINER	
DARBY & DARBY P.C. P.O. BOX 5257 NEW YORK, NY 10150-6257			NGUYEN, QUANG N	
			ART UNIT	PAPER NUMBER
			2141	

DATE MAILED: 03/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/790,332

Applicant(s)

ZHU ET AL.

Examiner

Quang N. Nguyen

Art Unit

2141

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 February 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Detailed Action

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 02/14/2006 has been entered.

Claims 1 and 16-19 have been amended. Claims 1-19 are presented for examination.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. **Claims 1 and 16-19 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.**

4. Applicants amended claims 1 and 16-19 with new limitation “determining an adaptive cut-off radius for a community based in part on a rate of growth for the community” and referred to its corresponding description in the specification (page 12, lines 10-15) for supporting the claimed amendment. After reviewing page 12, lines 10-15 of the specification which describes the effective cut-off radius should quickly decrease (from infinity when the address is new born, i.e., none or few first degree links) as the mailbox matures, Examiner respectfully submits that the claim(s) contains subject matter “determining an adaptive cut-off radius for a community based in part on a rate of growth for the community”, which was not described in such a way as to reasonably enable one skilled in the relevant art to which it pertains to make and/or use the invention.

Examiner respectfully requests that Applicants clearly point out “**how**” to enable one skilled in the art to “determine an adaptive cut-off radius for a community based in part on a rate of growth for the community”.

Claim Rejections - 35 USC § 101

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. Claims 18-19 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

7. As to claim 18, "A carrier wave signal" does not fit within any of the four statutory categories of patentable subject matter of § 101. "A carrier wave signal" is clearly not a process, machine, or composition of matter under § 101. Also, "A carrier wave signal" does not constitute a physical "manufacture" under § 101. As stated in *Diamond v. Chakrabarty*, 447 U.S. 303, 308, 206 USPQ 193, 196-97 (1980):

[T]his court has read the term "manufacture" in § 101 in accordance with its dictionary definition to mean "the production of articles for use from raw or prepared materials by giving to these materials new forms, qualities, properties, or combinations, whether by hand-labor or by machinery." *American Fruit Growers, Inc. v. Brogdex Co.*, 283 U.S. 1, 11 (1931).

Hence, "A carrier wave signal" must be claimed as a process, a system, or a computer-readable storage medium containing instructions for filtering messages for a node on a network.

8. As to claim 19, "A processor readable media ..., comprising:" is nonstatutory because it is not limited to tangible embodiments. In view of Applicant's disclosure on page 5, line 18 – page 6, line 2, the computer-readable media may include computer storage media, communication media, or any combination thereof, wherein the communication media includes "modulated data signal," and "carrier-wave signal", and other wired and wireless media such as acoustic, RF (radio frequency), infrared, etc. As such, the claim is not limited to statutory subject matter and is therefore nonstatutory.

To overcome this type of 101 rejection, Examiner respectfully suggests Applicants to amend the claim to include computer readable storage media/medium to store computer instructions executable by a computer processor to perform the steps of (for example, the claim should be amended as "A computer-readable storage media includes program codes/instructions executable by a computer processor for performing actions for filtering messages for a node on a network, comprising:"). See MPEP 2105, section IV. -- DETERMINE WHETHER THE CLAIMED INVENTION COMPLIES WITH 35 U.S.C. 101 – under subsection 1. Nonstatutory subject matter.

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

10. **Claims 1-19 are rejected under 35 U.S.C. 102(e) as being anticipated by Ingerman et al. (US 2004/0255122 A1), hereinafter referred as Ingerman.**

11. As to claim 1, **Ingerman** teaches a method for filtering messages for a node on a network, comprising:

determining an adaptive cut-off radius for a community based in part on a rate of growth for the community (*Ingerman teaches, for example, a particular messaging environment with 32 first degree contacts can be configured to store trust information up to four degree of separation, i.e., 32 to the exponent of 4th, or approximately one-million, other message entities, therefore, if said particular messaging environment with 8 first degree contacts then it can be configured to store up to five degree of separation, 8 to the exponent of 5th, equivalent to 32 to the exponent of 4th, based in part on a rate of growth for the community*) (**Ingerman**, paragraph [0091]);

determining a degree of separation between each of a plurality of nodes that are associated with a first node, wherein the first node and at least a portion of the associated plurality of nodes are granted membership in the community based on a number of degrees of separation between the first node and a second node in the community (*entities corresponding to message addresses 222, 223, and 224 retrieved from address list 221 can be viewed as one degree of separation away from entity 291*) (**Ingerman**, Fig. 2 and paragraphs [0054] and [0058]), and wherein the granting of membership in the community is limited by at least the adaptive cut-off radius for the community (*for example, a particular messaging environment can be configured to store trust information up to four degree of separation, or approximately one-million other message entities with 32 unique contacts for each degree of separation*) (**Ingerman**, paragraph [0091]);

determining a level of trust for the first node in the community based on the number of degrees of separation between the first node and another node in the community (*information in trust list, i.e., degrees of separation, can indicate a level of trust between 2 entities*) (**Ingerman, paragraphs [0052 and 0054]**); and

if a message is received by the first node in the community from the other node in the community, employing the level of trust associated with the other node to determine if the message is to be delivered to at least one trusted folder associated with the first node (*inherently, if the received message, whose sending address is identified or stored in the trust list, i.e., identified as a non-spam message, then it is transferred to the recipient user's inbox*) (**Ingerman, paragraph [0016]**).

12. As to claim 2, **Ingerman** teaches the method of claim 1, wherein the message is one of email, Short Message Service (SMS), Multi-Media Message Service (MMS), and Instant Message (IM) (*categorizing electronic messages*) (**Ingerman, paragraph [0017]**).

13. As to claim 3, **Ingerman** teaches the method of claim 1, wherein determining the degree of separation between each of the plurality of nodes associated with the first node, further comprises determining each degree of separation between each node based at least in part on a listing in at least one of a contact list, a buddy list, a received message, a forwarded message, a saved message, a sent message, an Internet Service Provider (ISP), an online chat room, an online group, on-line social network,

and a message classified as non-spam (*i.e., determining each degree of separation between each node based on address book entries*) (**Ingerman, paragraph [0054]**).

14. As to claims 4-5, **Ingerman** teaches the method of claim 1, wherein the number of degrees of separation between the first node and the second node in the community is selectable, and wherein the level of trust associated with the other node is selectable (**Ingerman, paragraph [0054]**).

15. As to claims 6-7, **Ingerman** teaches the method of claim 1, wherein the trusted folder includes at least one of an inbox folder and a folder where unread messages are further processed after a period of time, and wherein the processing after a period of time further comprises at least one of deleting the message, a white list filter, a black list filter, and a content filter (**Ingerman, paragraphs [0014 and 0016]**).

16. As to claim 8, **Ingerman** teaches the method of claim 1, further comprising if another message is received from a source outside the community of nodes, employing at least one anti-spam filter to perform at least one of delete the other message and deliver the message to an untrusted folder (*based on trust list information and/or activity store information, employing plug-ins to calculate the urgency of a message, categorize a message as an unwanted/unsolicited message, or cause other plug-ins such as a junk mail plug-in to process or bypass further processing*) (**Ingerman, paragraph [0048]**).

17. As to claim 9, **Ingerman** teaches the method of claim 1, wherein determining the degree of separation between each of the plurality of nodes, further comprises: determining if one of the nodes in the plurality of nodes is separated by one degree of separation from a number of nodes that is greater than a predetermined level (*e.g., 32 unique first degree contacts*); and identifying each node as a super node whose number of nodes that are separated by one degree of separation is greater than the predetermined level, wherein a level of trust for each node solely associated with super node is reduced (*plug-in 272 can be configured to categorize email 216 based on the desires of the plug-in developer, for example, the messaging environment can be configured to store trust information for up to four degrees of separation, and when a messaging entity has a reduced reliability index, the trust associated the messaging entity can decrease*) (**Ingerman, paragraph [0091]**).

18. As to claim 10, **Ingerman** teaches the method of claim 1, wherein determining the degree of separation, further comprises determining that a first degree of separation from the first node is a membership in at least one of a contact list and a buddy list (*entities corresponding to message addresses 222, 223, and 224 retrieved from address list 221 can be viewed as one degree of separation away from entity 291*) (**Ingerman, Fig. 2 and paragraph [0054]**).

19. As to claim 11, **Ingerman** teaches the method of claim 1, wherein the determining the degree of separation, further comprises determining that a first degree of separation from the first node includes a listing in more than one of a contact list (*i.e., entities corresponding to message addresses 222, 223, and 224 retrieved from address list 221 can be viewed as one degree of separation away from entity 291*), a buddy list, a received message, a forwarded message, a sent message, an Internet Service Provider (ISP) (*i.e., entities in the same domain, considered as local messaging entities*) an online chat room, an online group, an on-line social network, and a message classified as non-spam (**Ingerman, Fig. 2 and paragraphs [0020, 0054 and 0067]**).

20. As to claim 12, **Ingerman** teaches the method of claim 1, further comprising assigning a high level of trust to each node that is separated from the first node by one degree of separation (*assigning a high level to each node/entity in the address book, i.e., separated by one degree of separation*) (**Ingerman, paragraphs [0053-0054]**).

21. As to claim 13, **Ingerman** teaches the method of claim 1, further comprising if a number of first degree of separation associations with nodes for the first node is less than a threshold (*e.g., for less than 32 unique first degree contacts, then the messaging environment can be configured to store trust information up to four degree of separation, i.e., 32 to the exponent of 4th or approximately one-million, other messaging entities*), automatically providing membership in the community to each node associated with the first node (**Ingerman, paragraph [0091]**).

22. As to claim 14, **Ingerman** teaches the method of claim 1, further comprising revoking the level of trust associated with the other node based on actions related to unsolicited messages (*when a messaging entity is identified as sending unwanted and/or unsolicited messages, the trust associated the messaging entity can decrease, i.e., can be revoked*) (**Ingerman**, paragraph [0092]).

23. As to claim 15, **Ingerman** teaches the method of claim 1, further comprising enabling each message alias for one node to be handled as the same node (*inherently, an alias is an alternate label for some object, therefore each message alias for one node should be handled as the same node*).

24. Claims 16-19 are corresponding server, client, and carrier wave signal claims of method claim 1; therefore, they are rejected under the same rationale.

Response to Arguments

25. In the remarks, Applicant argued in substance that

(A) Prior Art (**Ingerman**) provides for no such adaptive cut-off radius for limiting prospective members in a community.

As to point (A), before addressing the argument, Examiner respectfully submits that the language of the limitation cited in the quotation “**an adaptive cut-off radius**” could be given broad and reasonable interpretation in light of specification as **a threshold or a number that the granting of membership in the community is limited by**. In this case, Ingerman teaches, for example, it maybe that in a particular messaging environment each message entity has 32 unique first degree contacts, each of the 32 unique first degree contacts also have 32 unique first degree contacts, etc. and that the particular messaging environment can be configured to store trust information up to **four degree of separation**, i.e., 32 to the exponent of 4th, or approximately one-million, other message entities (*i.e., up to four degree of separation or approximately one-million other message entities is the adaptive cut-off radius for limiting prospective members in the sample community*). In the same way, if said particular messaging environment just grew up to 8 first degree contacts then it could be configured to store up to **five degree of separation**, 8 to the exponent of 5th, equivalent to 32 to the exponent of 4th, hence, the cut-off radius **has been changed from five degree of separation for 8 first degree contacts to four degree of separation for 32 first degree contacts** for that particular messaging environment (*i.e., based in part on a rate of growth for the community*) (Ingerman, paragraph [0091]).

26. Applicant's arguments as well as request for reconsideration filed on 02/14/2006 have been fully considered but they are not deemed to be persuasive.

27. A shortened statutory period for reply to this action is set to expire THREE (3) months from the mailing date of this communication. See 37 CFR 1.134.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Quang N. Nguyen whose telephone number is (571) 272-3886.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's SPE, Rupal Dharia, can be reached at (571) 272-3880. The fax phone number for the organization is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


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SUPERVISORY PATENT EXAMINER